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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,674	01/29/2001	Teemu Tarnanen	PM276594	3264

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EXAMINER

MOORMAN, EARL J

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 06/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/744,674

Applicant(s)

TARNANEN ET AL.

Examiner

Earl J. Moorman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-8 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

### *Claim Objections*

2. **Claim 5** is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and/or cannot depend from any other multiple dependent claim. Accordingly, the claim has not been further treated on the merits.

### *Claim Rejections - 35 USC § 103*

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-4 and 6-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Joensuu et al. [U.S. Patent Number 5,966,653] (hereinafter Joensuu) in view of Alperovich et al. [U.S. Patent Number 6,459,680] (hereinafter Alperovich).

6. Regarding **claim 1**, Joensuu teaches a method for setting up USSD transfer [FIGs.2-6, numeral 100] for transmitting data between two parties, namely a mobile station [FIGs. 2-6, numeral 80] and a cellular communications network [FIG.2, numeral 10] wherein the USSD transfer takes place on a fast channel if the mobile station is involved in a call, and otherwise on a slow channel [col.1, lines 61-67; col.2, lines 20-29; col.2, lines 58-60; col.4, lines 33-65]. Joensuu fails to teach the method being characterized in that the amount of data to be transmitted is determined, and if the amount of data to be transmitted is likely to exceed a predetermined threshold, and if the mobile station is not involved in a call, the mobile station is directed to call mode for switching the USSD transfer to the fast channel.

However, Alperovich teaches the method being characterized in that the amount

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of data to be transmitted is determined, and if the amount of data to be transmitted is likely to exceed a predetermined threshold, and if the mobile station is not involved in a call, the mobile station is directed to call mode for switching the USSD transfer to the fast channel [col.2, lines 38-55; col.3, lines 36-58; col.5, lines 16-54; col.6, lines 59-67; col.7, lines 1-2; col.7, lines 60-67; col.8, lines 1-27].

Joensuu and Alperovich are combinable because they are from the same field of endeavor, that is, improving the performance of USSD transfer in cellular systems.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Joensuu to include Alperovich in order to determine if the amount of data being transmitted exceeds a threshold and if so, the mobile station is directed to call mode using the FACCH.

7. Regarding **claim 2**, Alperovich teaches a method characterized in that the mobile station is directed into call mode by initiating a call attempt [col.3, lines 36-58; col.4, lines 32-48; col.5, lines 34-37; col.6, lines 59-67; col.7, lines 1-2; col.8, lines 19-27].

8. Regarding **claim 3**, Alperovich teaches a method characterized in that the party that initiates the USSD transfer also initiates the call attempt [col.3, lines 36-58; col.4, lines 32-48; col.5, lines 34-37; col.6, lines 59-67; col.7, lines 1-2; col.8, lines 19-27].

9. Regarding **claim 4**, Alperovich teaches a method characterized in that the Network when initiating the USSD transfer, sends the mobile station an indication that the mobile station must initiate the call attempt [col.3, lines 36-58; col.4, lines 32-48; col.5, lines 34-37; col.6, lines 59-67; col.7, lines 1-2; col.8, lines 19-27].

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10. Regarding **claim 6**, Joensuu teaches a mobile station [FIGs. 2-6, numeral 80], adapted for setting up USSD transfer [FIGs.2-6, numeral 100] for transmitting data between itself and a cellular communications network [FIG.2, numeral 10], wherein the USSD transfer takes place on a fast channel if the mobile station is involved in a call, and otherwise on a slow channel [col.1, lines 61-67; col.2, lines 20-29; col.2, lines 58-60; col.4, lines 33-65]. Joensuu fails to teach a method characterized in that the mobile station is adapted to determine the amount of data to be transmitted; and initiate a call attempt for switching the USSD transfer to the fast channel if the amount of data to be transmitted is likely to exceed a predetermined threshold and if the mobile station is not involved in a call.

However, Alperovich teaches a method characterized in that the mobile station is adapted to determine the amount of data to be transmitted; and initiate a call attempt for switching the USSD transfer to the fast channel if the amount of data to be transmitted is likely to exceed a predetermined threshold and if the mobile station is not involved in a call [col.2, lines 38-55; col.3, lines 36-58; col.5, lines 16-54; col.6, lines 59-67; col.7, lines 1-2; col.7, lines 60-67; col.8, lines 1-27].

Joensuu and Alperovich are combinable because they are from the same field of endeavor, that is, improving the performance of USSD transfer in cellular systems. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Joensuu to include Alperovich in order to determine if the amount of data being transmitted exceeds a threshold and if so, the mobile station is directed to call mode using the FACCH to initiate a call attempt.

11. Regarding **claim 7**, Joensuu teaches an arrangement for a cellular communications network [FIG.2, numeral 10], adapted for setting up USSD transfer [FIGs.2-6, numeral 100] for transmitting data between itself and a mobile station [FIGs. 2-6, numeral 80], wherein the USSD transfer takes place on a fast channel if the mobile station is involved in a call, and otherwise on a slow channel [col.1, lines 61-67; col.2, lines 20-29; col.2, lines 58-60; col.4, lines 33-65]. Joensuu fails to teach a method characterized in that the arrangement is adapted to: determine the amount of data to be transmitted; and initiate a call attempt for switching the USSD transfer to the fast channel if the amount of data to be transmitted is likely to exceed a predetermined threshold and if the mobile station is not involved in a call.

However, Alperovich teaches a method characterized in that the arrangement is adapted to: determine the amount of data to be transmitted; and initiate a call attempt for switching the USSD transfer to the fast channel if the amount of data to be transmitted is likely to exceed a predetermined threshold and if the mobile station is not involved in a call [col.2, lines 38-55; col.3, lines 36-58; col.5, lines 16-54; col.6, lines 59-67; col.7, lines 1-2; col.7, lines 60-67; col.8, lines 1-27].

Joensuu and Alperovich are combinable because they are from the same field of endeavor, that is, improving the performance of USSD transfer in cellular systems. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Joensuu to include Alperovich in order to determine if the amount of data being transmitted exceeds a threshold and if so, the mobile station is directed to call mode using the FACCH to initiate a call attempt.

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12. Regarding **claim 8**, Alperovich teaches an arrangement characterized in that it is adapted to initiate a call attempt by sending to the mobile station an indication that the mobile station must initiate the call attempt [col.3, lines 36-58; col.4, lines 32-48; col.5, lines 34-37; col.6, lines 59-67; col.7, lines 1-2; col.8, lines 19-27].

**Conclusion**

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Patel [U.S. Patent Number 5,835,856]

Valentine et al. [U.S. Patent Number 6,044,263]

Bhatia [U.S. Patent Number 6,052,591]

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Earl J. Moorman whose telephone number is (703) 305-8158.

The examiner can normally be reached on Monday-Friday 7:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William G. Trost can be reached on (703) 308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-9508 for regular communications and (703) 305-9508 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Earl Moorman  
June 17, 2003

EJM

W-T

WILLIAM TROST  
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